

Appln No. 09/785,643

Amdt date April 22, 2005

Reply to Office action of December 22, 2004

REMARKS/ARGUMENTS

Initially, Applicant notes that the Examiner has apparently not returned an initialed copy of Form PTO/SB/08A/B filed with Applicant's Information Disclosure Statement filed on December 3, 2004. If the Examiner requires a further copy of the Information Disclosure Statement, Applicant respectfully requests that the Examiner contact Applicant's undersigned counsel of record.

Applicant thanks the Examiner for his careful consideration of this application. In response to the above-identified Office action, Applicant amends the application and seeks reconsideration, reexamination and allowance thereof. In this case, applicant does not cancel or add any claims. Applicant amends claims 14 and 15. Accordingly, claims 1-46 are pending in the application.

I. Claims Rejected Under 35 U.S.C. § 103

Claims 1-12, 14, 15, 19-21, 24-29, 34, 35 and 39-42 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,598,477 issued to *Berson* (hereinafter, "*Berson*") in view of U.S. Patent No. 5,621,797 issued to *Rosen* (hereinafter, "*Rosen*"). Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

In order to establish a *prima facie* case of obviousness, the Examiner must show that the cited references, combined, teach or suggest each of the elements of the claim. Further, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion or motivation to do so, found either explicitly or implicitly in the references themselves or in the knowledge generally available to the one of ordinary skill in the art. See, MPEP §2143.01.

In regard to independent claims 1, 19 and 39 these claims include the elements of "determining a validity status for the value bearing indicium data using the validation information database" and "transmitting the validity status to the scanning machine." The Examiner acknowledges on page 4 of the Office action mailed December 22, 2004 that *Berson* does not teach these elements of independent claims 1, 19 and 39. Rather, the Examiner relies on *Rosen*, citing Col. 25, lines 15-67, as teaching these elements of the claims. However, the Applicant has reviewed this cited section of *Rosen* and is unable to discern any part therein that teaches these elements of claims 1, 19 and 39. Rather, the cited section of *Rosen* discusses a system for conducting an online transaction between two trusted agents using a ticket. See *Rosen*, Col. 4, lines 45-50. In the section of *Rosen* cited by the Examiner, a ticket is used by its owner through a customer trusted agent A to receive services from a seller's merchant trusted agent B. See *Rosen*, Col. 25, lines 16-18. A host transaction application (HTA) A associated with the customer trusted agent and an HTA B associated with a merchant trusted agent share information from the ticket in order to make the purchase of the required services. See *Rosen*, Col. 25, line 15 through Col. 26, line 10. Applicant has reviewed this section and is unable to discern any part therein that refers to the use of a database in this process or the use

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of a scanner. Thus, the Examiner has not established that Rosen teaches "determining a validity status for the value bearing indicium using the validation information database" or "transmitting the validity status to a scanning machine." Therefore, the Examiner has failed to establish that Berson in view of Rosen teaches or suggests each of the elements of claims 1, 19 and 39.

Further, the Examiner argues that Rosen would be combined with Berson in order to "provide the validation system of Berson with the determining a validity status for the value bearing indicium data using the validation information database and transmitting the validity status to the scanning machine of Rosen in order to authenticate the validity of the value bearing indicium." However, the system taught by Berson is already capable of authenticating the validity of the ticket after being read by the scanner without the use of a database. Thus, one of ordinary skill in the art would not be motivated to combine Rosen with Berson in order to authenticate the validity of the value bearing indicium as Berson is already capable of this. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claim 1 based on Berson in view of Rosen. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 1, 19 and 39 are requested.

In regard to claims 2-12, 20-32 and 40-42 these claims depend from independent claims 1, 19 and 39 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claims 1, 19 and 39 these claims are not obvious over Berson in view of Rosen. Accordingly,

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reconsideration and withdrawal of the obviousness rejection of these claims are requested.

Claims 14, 15, 34, and 35 appear to be improperly rejected under *Berson* in view of *Rosen*. These claims depend from independent claims 13 and 33. Independent claims 13 and 33 have been rejected over other references. Thus, it is unclear how these dependent claims can be taught or suggested by *Berson* in view of *Rosen* when the Examiner has not established that *Berson* in view of *Rosen* teaches or suggests the elements of the independent claims from which they depend. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

Claims 13, 16-18, 22, 23, 30-33, 36-38 and 43-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,233,565 issued to *Lewis, et al.* (hereinafter, "*Lewis*") in view of *Berson*. Applicant respectfully requests the Examiner reconsider and withdraw these rejections.

The rejections set forth in the Office action mailed December 22, 2004, in relation to claims 13, 16-18, 22, 23, 30-33, 36-38 and 43-46 are identical to those set forth for these claims in the previous Office action. The Examiner has not responded to or acknowledged the arguments set forth by the Applicant in the prior response dated October 19, 2004. Applicant again restates and reiterates the arguments it made in its earlier response and requests that the Examiner cite the portions of the references on which he is relying to reject the particular claims of this invention. Applicant has reviewed the cited sections set forth by the Examiner, but the citations do

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not disclose or suggest the elements of the claims for which the Examiner cites the references.

In regard to claims 13 and 33, these claims include the elements of "determining a validity status for the ticket by the ticket server using the validation information database," "transmitting the validity status to the scanning machine by the ticket server via the computer network," and claim 13 includes an additional element of "transmitting the validity status to the distributor server by the ticket server via the computer network." The Examiner has not identified, and Applicant has been unable to discern, any part of *Lewis* or *Berson* that teaches or suggests these elements of claims 13 and 33. Rather, as discussed above in the regard to independent claim 1, *Berson* does not teach the use of a validation information database transmitting validity status to a scanning machine and also does not teach transmitting validity status from a ticket server to a distributor server. Applicant has reviewed the cited section of *Lewis* but has been unable to discern any part therein that teaches these elements. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness based on *Lewis* in view of *Berson*. If the Examiner maintains this rejection of claims 13 and 33, Applicant respectfully requests that the Examiner particularly point out those sections of *Lewis* and *Berson* that teach these elements of claims 13 and 33, and that the Examiner address the arguments set forth by the Applicant in regard to these claims.

In regard to claims 16-18 and 36-38, these claims depend from independent claims 13 and 33 and incorporate the

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limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claims 13 and 33, these claims are not obvious over *Lewis* in view of *Berson*. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 13 and 33.

In regard to claims 22, 23 and 30-32, these claims depend from independent claim 19 and incorporate limitations thereof. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for these claims as the Examiner has not set forth how the independent claim is taught or suggested by *Lewis* in view of *Berson*. Thus, the dependent claims cannot be unpatentable over *Lewis* in view of *Berson*. Accordingly, reconsideration and withdrawal of the obviousness rejection to claims 22, 23 and 30-32 are requested.

In regard to claim 43, this claim includes the elements of "generating a message digest by hashing a first subset of the relevant information," "generating a digital signature from the message digest," "generating a 2-D bar code from a second subset of the relevant information" and "printing the digital signature and the 2-D bar code next to each other as a value bearing indicium." The Examiner has not set forth, and the Applicant has been unable to discern, any part of the cited references that teaches or suggests using two different subsets of provided information to generate the digital signature and the 2-D bar code and then printing this digital signature and 2-D bar code next to each other as part of a value bearing indicium. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claim 43 based on *Lewis* in view of *Berson*.

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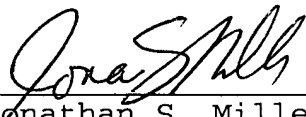
Accordingly, reconsideration and withdrawal of the obviousness rejection of this claim are requested.

Claims 44-46 depend from independent claim 43 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claim 43, these claims are not obvious over Lewis in view of Berson. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

II. Conclusion

In view of the foregoing, it is believed that all claims now pending, namely claims 1-46, patentably define the subject invention over the prior art of record and are in condition for allowance, and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (626) 795-9900.

Respectfully submitted,
CHRISTIE, PARKER & HALE, LLP

By 
Jonathan S. Miller
Reg. No. 48,534
626/795-9900

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